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In re Application of
LAPPE et al.
Application No.: 10/562,083
PCT No.: PCT/EP04/06858
Int. Filing Date: 24 June 2004
Priority Date: 27 June 2003
Attorney's Docket No.: 11336.1235
For: A METHOD AND SYSTEM FOR COORDINATING
THE ROUTES OF A PLURALITY OF DEVICES

DECISION ON
PETITION
UNDER 37 CFR 1.47(b)

This is a decision on petition under 37 CFR 1.47(b), filed 02 November 2006 to permit petitioner (applicant) to file the above-captioned application on behalf of the non-signing inventors Dirk Lappe, Stefan Wolf, Hermann Dibos and Guido Hovestadt. Petitioner requested a five month extension of time, which is granted.

BACKGROUND

On 24 June 2004, applicant filed international application No. PCT/EP04/06858 which claimed a priority date of 27 June 2003, and which designated the United States. A copy of the international application was communicated to the United States by the International Bureau on 06 January 2005.

On 23 December 2005, within 30 months from the priority date, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, basic national filing fee.

On 24 March 2006, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS indicating that the oath or declaration of the inventor, in compliance with 37 CFR 1.497(a) and (b) must be furnished within two months from the mail date of the notice or the application would be abandoned. Extensions of time were available.

On 02 November 2006, petitioner filed the instant petition requesting that the above-identified application be accepted under the provisions of 37 CFR 1.47(b). The petition was accompanied by a declaration of Dr. Tim Bast and copies of German Claiming Letters signed by the inventors.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the requisite petition fee, (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a

showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Petitioner has satisfied Item (1) with payment of the requisite petition fee and Item (3) with a statement of the last known addresses of the inventors.

As for Item (4), petitioner has provided a declaration, in compliance with 37 CFR 1.497(a) and (b) and executed on behalf of the inventors by the 37 CFR 1.47(b) petitioner and is required. Item (4) is satisfied.

With regard to Item (2), a statement by Dr. Tim Bast, European Intellectual Property Counsel for Harmon International Industries, Inc. was provided. Dr. Bast indicates that Janine Doss, an Assistant, contacted the nonsigning inventors to obtain their signatures on the declaration documents. A first hand statement from Ms. Doss is required. Also copies of the correspondence and emails to the nonsigning inventors were not provided and are required to prove the inventors refused to sign. Proof of delivery of the application and the declaration should be submitted as part of the renewed petition under 37 CFR 1.47(b). No attempts to contact the nonsigning inventor via telephone, current employers, etc. were discussed. Petitioner does not clearly demonstrate that the nonsigning inventors are refusing to sign this application.

Petitioner must provide proof that the inventor was presented with a copy of the application papers (including specification, claims, and any drawings) in order to conclude that the inventor refuses or is unavailable to sign the application. See MPEP. 409.03(d), which states in pertinent part, "a refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers." Here, there is no clear evidence from someone having first hand knowledge that nonsigning inventors were presented with a copy of the application papers and that they are refusing to sign the application at issue. Petitioner must present sufficient evidence to conclude that the inventors refuse to sign the application. The statement of someone having first hand knowledge of the facts is required. See MPEP. 409.03(d) for further instructions. Item (2) is not satisfied.

Regarding Item (5), Section 409.03(f) of the MPEP, Proof of Proprietary Interest, states, in part:

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that

- (A) the invention has been assigned to the applicant, or
- (B) the inventor has agreed in writing to assign the invention to the applicant, or
- (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

If the application has been assigned, a copy of the assignment (in the English Language) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant. A statement under 37 CFR 3.73(b) by the assignee must also be submitted (see MPEP § 324)....

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by a statement of facts by someone

with first hand knowledge of the circumstances in which those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by the affidavit or declaration of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

If the invention has not been assigned, or if there is no written agreement to assign, the 37 CFR 1.47(b) applicant must demonstrate that he or she otherwise has a sufficient proprietary interest in the matter.

A proprietary interest obtained other than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

No assignment signed by the inventor was attached to the petition to prove this interest.

Where there is no written agreement to assign or the invention has not been assigned, petitioner must demonstrate a proprietary interest by an appropriate legal memorandum. No such memorandum accompanied the petition.

Here Petitioner, in attempting to prove that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the subject matter to justify filing the application, provided copies of German Claiming Letters. However, these letters do not reference the above identified U.S. application or PCT application. A copy of the German statute and an English translation thereof is required. Where the employee (nonsigning inventor) agreed to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment, a copy of the employee agreement must be provided along with a firsthand knowledge statement that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant and that all conditions were met is required. When such an agreement is relied on, it must be established by the affidavit or declaration of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant. Item (5) is not satisfied. In the alternative, a proprietary interest obtained other than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum. See Section 409.03(f).

As for Item (6), irreparable damage may be established by a showing (a statement) that a filing date is necessary to preserve the rights of the party and to prevent irreparable damage. Such statement has been presented in paragraph (I) of the petition. Thus, item (6) is satisfied.

Accordingly, items (2) and (5) above have not been satisfied and the petition under 37 CFR 1.47(b) must be dismissed.

CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED WITHOUT PREJUDICE**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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